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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,204	01/18/2002	William Touzani	Touzani-1-1	7168

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EXAMINER	
LONEY, DONALD J	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/051,204	Touzani
Examiner	**Group Art Unit**
D. Lowe	1772

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on June 19, 2003.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-12, 22 23 is/are pending in the application.

Of the above claim(s) 22, 23 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 - 12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

1. Applicant's election without traverse of Group I in Paper No. 6 is acknowledged.

In the above paper number, the applicant indicates that claims 1-12 are pending and cancels claims 13-21. Claims 22 and 23 also need to be cancelled. The examiner believes the applicant inadvertently failed to do so since they are drawn to a non-elected invention and are dependent from a cancelled claim (i.e. claim 21). Correction is kindly requested.

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states, "Whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 1-3, 5 and 6 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11-13, 15 and 16 respectively of copending Application No. 09/961,947. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 5-19 of copending Application No. 09/961,947. Although the conflicting claims are not identical, they are not patentably distinct from each other because the attaching member of the instant claims would be obvious over the adhesive means in 09/961,947.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the face wall, back wall and spaces are recited as formed from a "corrugated sheet." The examiner does not believe each of these is individually formed of a corrugated sheet. The examiner believes the applicant is attempting to claim the overall structure of corrugated as referred to as element 62 in the Figures and Specification. This does not appear to be corrugated as known in the art. It appears to be an article with longitudinal cells therein. Clarification is kindly requested.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

9.

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Barber.

Barber teaches a holder containing face sheets (10 and 12) inter-connected with spacers (11 on the edges and 15, 16 in the interior. Element 13 and/or 14 can be considered the attaching member. Refer to Fig. Nos. 1-4 along with column 1, line 43 through column 2, line 19.

11. Claims 1, 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Boender.

Boender teaches an article having parallel face sheets (1 and 2) with spacers (30) there between which form tubular cells. The flange (4 or 7) can be considered the attaching member is its broadest sense since no structure is recited in the claims to distinguish therefrom. Refer to Figure Nos. 1-4 along with column 2, lines 48-69. The corrugated claims 2 and 4 are included in this rejection since the structure is the same as applicants 62 in the Figures and Specification, which is referred to as corrugated.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 3 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber in view Hayduchok.

The primary reference teaches the invention substantially as recited except for the Velcro and alternative connection means of instant claims 6-12. Barber does disclose a connection 13 and/or 14.

Hayduchok teaches to use Velcro as a connection means to mount a penholder. Refer to Figure Nos. 15 and 16 element 65 a.

Therefore, it would have been obvious to one having ordinary skill in the art to use Velcro as or attaching member, as taught by Hayduchok, for the purpose of mounting the holder in its desired position since Barber teaches attaching members with respect to the other embodiments and to substitute one attaching means for another would be obvious to a skilled artisan. The specific materials of claim 3 are also deemed obvious since the primary reference teaches to form the holder of plastic, of which the materials of claim 3 are.

Any inquiry concerning this communication should be directed to Examiner D. Loney at telephone number (703) 308-2416.

DONALD J. LONEY
PRIMARY EXAMINER

D. Loney/dh
September 23, 2003